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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

743421-000079

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on _____

Signature _____

Typed or printed name _____

Application Number

10/507,116

Filed

2004-09-10

First Named Inventor

Masafumi Fukuzumi

Art Unit

1742

Examiner

SHEEHAN, JOHN P.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

/Stephen M. Hertzler, Reg. No. 58,247/

applicant/inventor.

Signature

Stephen M. Hertzler

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Typed or printed name

attorney or agent of record. 58247

202,585,8000

Registration number _____

Telephone number

attorney or agent acting under 37 CFR 1.34.

2007-09-10

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

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PATENT
ATTORNEY DOCKET NO. 743421-000079

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Group Art Unit: 1742
Masafumi FUKUZUMI et al.) Examiner: John P. Sheehan
Application No.: 10/507,116) Confirmation No.: 4195
Filed: September 10, 2004)
For: RARE EARTH SINTERED MAGNET)
AND METHOD FOR PRODUCTION)
THEREOF) Date: September 10, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request formal review of the May 8, 2007, Final Office Action, and the August 13, 2007, Advisory Action. In particular, the Examiner has clearly maintained improper rejections of claims 1 to 4, 8 and 10 to 13 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,595,608 to Takebuchi et al., and claims 6 and 7 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Japanese Patent Document No. 04-268051 to Ueda et al.

In an effort to overcome the above rejections, Applicants have amended the claims to include specific, tangible characteristics of the claimed invention. Specifically, in the last response, Applicants amended claim 1 to include the limitation “50 at% to 90 at% of the overall grain boundary phase is Co.” Similarly, Applicants amended claim 8 to include the limitation “the liquid phase alloy including 60 at% to 80 at% of R and 20 at% to 40 at% of Co.” In the response, the Applicants explained the importance of these limitations and the novel features resulting from compliance thereto.

For example, with respect to claim 1, according to the claimed magnet, the natural electrode potential of the grain boundary phase increases to -0.75 V or more, too, and the difference in natural electrode potential between the main and grain boundary phases can be reduced to at most 0.6 V, as described in the specification of the present application. Thus, it is possible to prevent corrosion from being produced by a cell reaction between the main and grain boundary phases. This advantageous characteristic results from the amount of Co in the grain boundary phase.

With respect to claim 8, an alloy including a rare-earth element R and Co as its main ingredients is used as the liquid phase alloy so as to reduce the difference in natural electrode potential between the main and grain boundary phases. If the concentration of Co in the liquid phase alloy were less than 20 at%, the natural electrode potential of the resultant grain boundary phase would not become sufficiently high and the difference in natural electrode potential between the main and grain boundary phases would be too big to exhibit the corrosion resistance sufficiently. Nevertheless, if the concentration of Co in the liquid phase alloy exceeded 40 at%, then ferromagnetic RCO₂ would be easily produced in the grain boundary phase of the resultant sintered magnet, thus deteriorating the magnet performance unintentionally. Again, these characteristics result from the claimed amount of Co in the liquid phase alloy.

The primary applied reference, Takebuchi, completely fails to disclose, suggest, or render obvious at least the claimed amounts of Co. Applicants further included explanations of the unexpected benefits of the claimed amounts of Co by describing unexpected advantages that are achieved through the use of the claimed products including the claimed amounts of Co, including the discussed electrode potentials.

However, despite Applicants attempts to overcome these rejections, the Examiner taken the position that “Applicants’ argument regarding claim 1 and the electrode potential of the grain boundary phase ... and Applicants’ argument regarding claim 8 and the difference in the natural electrode potential of the main phase and grain boundary phase are not persuasive in that claims 1 and 8 are silent with respect to the electrode potential of the grain boundary phase and the difference in the natural electrode potential of the main and grain boundary phase respectively...Further, as set forth in the statement of the rejection regarding the claims that do not recite properties not taught by the references, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been

obvious because the alloys taught by the references are encompassed by the claims." The Examiner once again relies on *In re Best* when making this argument.

The Examiner has failed to provide any reasoning whatsoever that indicates that Takebuchi discloses the claimed characteristics. Accordingly, as the Examiner has failed to assert that Takebuchi discloses each and every feature in the claims, it is clearly improper to maintain an anticipation rejection of the claims under 35 U.S.C. § 102(b) in view of Takebuchi. Therefore, Applicants respectfully submit that this rejection should be withdrawn.

This paper is being filed concurrently with a Notice of Appeal and the requisite fee, as required in the guidelines for the New Pre-Appeal Brief Conference Pilot Program published in the July 12, 2005, Official Gazette Notice.

In view of all of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and prompt notification of the same is earnestly sought.

Respectfully submitted,

Date: September 10, 2007

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